

**REMARKS**

This responds to the Office Action mailed on June 16, 2005.

No claims are amended, claims 26-31 are canceled, and no claims are added; as a result, claims 22-25 and 32-35 are now pending in this application.

**Claims 26-31**

The Office Action notes that claims 26-31 are directed to a non-elected invention because the apparatus can be used in a different method than is being claims and withdrew the claims. While not expressly admitting this, Applicant presently cancels claims 26-31 without prejudice or disclaimer, and reserves the right to reintroduce the non-elected claims in a Divisional application at a later date.

**§102 Rejection of the Claims**

Claims 22-25 and 32-35 were rejected under 35 USC § 102(b) as being anticipated by Rondeau (U.S. 5,850,433).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

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With respect to claims 22 and 32, applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation in that the reference does not teach each and

every claim element.

Applicant fails to find in Rondeau:

a server comprising:

a registry comprising identifications of services and identifications of peers that perform the services;

and a second electronic device to receive a service request from a first electronic device, to fulfill a portion of the service request, to find a third electronic device using the registry server, and to send a remaining portion of the service request to the third electronic device

as recited in claims 22, 32.

The Office Action states that a recitation of intended use must result in a structural difference between the claimed invention and the prior art and that the claim is anticipated by Rondeau, in that Rondeau recites a server, registry and an electronic device and that the ability of the prior art structure to perform the intended use is inherent. Applicant respectfully disagrees because the Office Action has failed to establish a *prima facie* case of inherency.

“In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

With respect to claims 22 and 32, applicant respectfully submits that in the present case, Rondeau does not teach a:

second electronic device to receive a service request from a first electronic device, to fulfill a portion of the service request, to find a third electronic device using the registry server, and to send a remaining portion of the service request to the electronic device

as recited in claim 22. Applicant respectfully submits that Rondeau teaches a call center where a customer can find telephone numbers associated with some provider (Abstract). It appears to the Applicant that in Rondeau the full service request is fulfilled by the server center 12 (Fig. 1). Applicant fails to find in the Office Action any basis in fact or technical reasoning supporting the argument that the positive functional limitations discussed above flow from Rondeau. Applicant respectfully submits that Rondeau models or emulates a single search engine. Further, the single

search engine provides an on-line directory service that includes a database containing a plurality of directory listings. When queried by the customer the search engine enables the customer to select one of the listings in its entirety. The entire transaction occurs between the customer and the search engine, with no other device involved.

Applicant fails to find in Rondeau a device to fulfilling a portion of the service request as is recited in claims 22 and 32, which has the same features described herein. Applicant respectfully submits that claims 22 and 32 are allowable for at least these reasons.

With respect to claims 23-25 and 33-35, which properly depend from claims 22, 32, Applicant respectfully submits that a dependent claim contains all the patentable features in the independent claim from which it properly depends. Applicant respectfully submits that claims 23-25 and claims 33-35 are allowable over the cited patents for at least the reasons stated above with respect to claims 22, 32.

Applicant respectfully requests reconsideration in view of the above and submits that claims 22-25 and 32-35 are each allowable for at least the reasons stated above. Applicant respectfully requests the withdrawal of the 102(b) rejection and allowance of the claims.

Documents Cited but Not Relied upon for this Office Action

Applicant need not respond to the assertion of pertinence stated for the patents listed but not relied upon by the Office Action since these patents are not made part of the rejections in this Office Action. Applicant is expressly not admitting to this assertion of pertinence and reserves the right to address it should it or the listed patents form part of future rejections.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6900) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

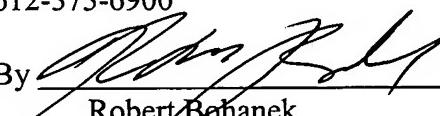
Respectfully submitted,

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Date

9/16/05

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16th day of September, 2005.

Name

Amy Moriarty

Signature

